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| 09/981,467      | 10/17/2001  | Max Stern            | STN.0101            | 5932             |

7590 12/10/2003  
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EXAMINER

CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/981,467

Applicant(s)

STERN, MAX

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a response to the Amendment received on September 30, 2003, in which claims 1, 3-7 and 11 were amended, claim 16 was added, and claims 9-10 and 12-15 were cancelled. Claims 1-8, 11 and 16 are pending.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kadlic (U.S. Patent No. 5,816,915).

Kadlic discloses a poker game (abstract) that includes each game element having a selected color and playing indicia on each of the elements (Figure 1).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (U.S. Patent No. 5,976,016; hereafter "Moody").

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Referring to claims 1-2, 4 and 6-8, Moody discloses a game machine having a typical poker-like game using any game symbol on a game element using any suitable payable (3:55-4:24), but does not specifically disclose that the symbols use a specific order, such as numbers 0-9, of the game elements to be indicate a winning combination in a payable. However, it is notoriously well known within the art of poker games to include a standard payable that awards players achieving symbols in a specific order (straight flush consisting of A-2-3-4-5 and a Royal Flush). One would be motivated to provide the ordering of game symbols, such as 0-9 or A-K, and a corresponding payable into Moody in order to attract players who normally play the poker games and prefer higher payouts and since Moody allows alternative game symbols on the game elements with a corresponding payable. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a specific order to game symbols and corresponding payable in order to attract players who normally play the poker games and prefer higher payouts.

Referring to claims 3-4, Moody discloses using cards, but does not disclose using a group of colored balls. However, the feature of balls as game elements, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to standout from other similar poker type games. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of balls as the game elements of Moody in order to satisfy the particular gaming theme and standout from other similar poker games. Furthermore, Applicant suggests in the disclosure that other elements, besides a ball, can be used as long as the

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elements satisfy the distribution of 5 groups with each group having at least 10 elements (Page 6, line 21 to Page 7, line 3).

Referring to claim 5, Moody discloses the number of elements is five (Figure 1) and further that a player has the option to hold and discard game elements and the player receives three four or five redistributed game elements. Alternatively, it is notoriously well known in the art of poker to play with poker hands of three or four game elements in order to differentiate the poker type game from other poker type games and create more interest for the game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use three or four card poker hands into Moody in order to create more interest in the poker game.

Claims 11 and 16 correspond in scope to a gaming method set forth for use of the gaming method listed in the claims above and are encompassed by use as set forth in the rejection above.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, 11 and 16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Weingardt (U.S. Patent No. 5,042,818) discloses offering higher payouts if a player achieves a particular card hand in order or in sequence.

(16:3-5)

AJC

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

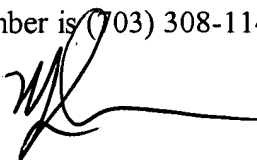
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc



MARK SAGER  
PRIMARY EXAMINER